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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,942	04/05/2005	Christoph Von Mandach	9593.18619-PCT US	6984
26308	7590	10/04/2005	EXAMINER	
RYAN KROMHOLZ & MANION, S.C. POST OFFICE BOX 26618 MILWAUKEE, WI 53226			KILKENNY, PATRICK J	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/506,942	VON MANDACH, CHRISTOPH	
	<b>Examiner</b>	<b>Art Unit</b>	
	Patrick J. Kilkenney	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 4/05/2005.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 24-49 is/are pending in the application.
- 4a) Of the above claim(s) 28-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 28-49 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 24-27, are drawn to a process for the application of an orthodontic fastening part classified in class 433, subclass 29.
- II. Claims 28-49, are drawn to an various apparatuses for use in the application of an orthodontic fastening part to a tooth:
  - 1) Claims 28-30 are drawn to an orthodontic fastening part, classified in class 433, subclass 9.
  - 2) Claims 31-36 are drawn to a protector for attachment to a fastening part classified in class 433, subclass 3.
  - 3) Claims 37-49 are drawn to an applicator for applying an orthodontic fastening part and attached protector to a tooth, classified in class 433, subclass 3.

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case method of applying an orthodontic fastening part, I, can be performed by other orthodontic application tools.

Because these inventions are distinct for the reasons given above and have acquired a separated status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Attorney John Manion on 8/8/05 a provisional election was made without traverse to prosecute the invention I, claims 24-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 28-49 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 9/08/2004 is noted. The submission is in compliance with the provisions of 37 CFR 1.97 and 1.98. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 24 and 25 are rejected under 35 U.S.C. 102(B) as being anticipated by Dellinger (4,360,341). Dellinger discloses a method for the application of an orthodontic fastening part (Fig.5, #18), which includes covering the fastening part with a complementary protector (Fig. 5, # 24), accommodating the fastening part/protector combination with a complementary applicator (Fig. 5, #32), depositing adhesive onto the fastening part and allowing the adhesive to cure, after which the protector and applicator are removed (Column 3, lines 58-62). The fastening part is aligned on the tooth by the contoured ends, which have been preformed to each tooth surface and help align the fastening part (Fig. 3, #'s 34 and 36).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dellinger. Dellinger discloses the claimed method except for the orthodontic fastening part and the protector being attached in a preassembled manner. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Dellinger by integrally combining the orthodontic fastening part (Fig. 5, #18) and the protector (Fig. 5, #24), since it has been held that forming in one

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piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dellinger in view of Podszun et al. (5,921,779). Dellinger discloses the claimed method with the exception of using a polymerization lamp for curing the dental adhesive. Podszun et al. discloses using a polymerization lamp for curing dental adhesive (Column 4, lines 61-63). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize a polymerization lamp to cure the dental adhesive, as taught by Podszun, and as is well known in the art, in order to rapidly cure the dental adhesive and obtain a strong bond between the orthodontic fixing element and the tooth.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick J. Kilkenny whose telephone number is (571)272-8684. The examiner can normally be reached on Mon-Fri, 8-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
PJK

  
Patrick J. Kilkenney  
Art Unit 3732  
October 3, 2005  
10/3/05

  
Cary E. O'Connor  
Primary Examiner